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U.S. Appln. S.N. 10/518,342
AMENDMENT

PATENT

REMARKS

This Amendment adds new claims 15-18 and amends claims 1, 4-8 and 11-13. New claims 15 and 16 are supported by preferred embodiments canceled from 1 and 5, respectively. New claims 17 and 18 are supported by preferred embodiments canceled from claims 4 and 13, respectively. Claims 1, 4-7 and 11-13 have been amended by deleting "preferred" limitations. The dependencies of claims 5 and 6 have been changed from claim 1 to claim 4, while claim 8 now depends from claim 6. Claims 1 and 12 have been further amended by changing "comprising" to --consisting of-- in two Markush groupings. Claims 1-18 are pending.

This Amendment overcomes the 35 U.S.C. § 112, first paragraph, rejection of claims 1-14. "Comprising" has been replaced with --consisting of -- in claims 1 and 12, thereby overcoming the improper Markush ground for rejection. Reconsideration and withdrawal of the § 112, first paragraph, rejection of claims 1-14 are earnestly requested.

The 35 U.S.C. § 103(a) rejection of claims 1-14 over European Patent Publication 712956 to Sato et al. in view of U.S. Patent No. 6,354,620 to Budden et al. is respectfully traversed. A feature of the claimed crosslinkable silicone composition is a particulate component D which consists of powdered (co)polyamides having a

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substantially rounded shape and a mean particle diameter of 0.1 to 200 μm . A second feature of the claimed composition is a particulate component E which consists of powdered silicas having a mean particle diameter of about 0.1 μm or less and a BET specific surface area greater than 50 m^2/g . The composition is particularly suitable for reducing the coefficient of friction of substrates such as textiles.

The cited combination of references fails to raise a prima facie case of obviousness against the claimed composition because one of ordinary skill in the art would not combine the cited references. As conceded by the Patent Office, Sato et al. fails to disclose the silica particulate feature of the claimed crosslinkable silicone composition.

Sato et al. teaches reducing the coefficient of friction of a rubber coated fabric by the addition of its coating composition. One of ordinary skill in the art would not modify Sato et al. by adding powdered silica to its composition because the addition of fillers such as silica can increase friction, as expressly taught by Budden et al. See Col. 7, lines 13-16.

The claimed composition exhibits a reduced coefficient of friction, which is an unexpected and surprising result in view of the prior art. More particularly, Budden et al. teaches that

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reinforcing fillers such as silica can increase the coefficient of friction of a silicone-based composition. Yet comparison of Example 4 to Example 3 of the present application demonstrates that the addition of a silica powder reduces the coefficient of friction and enhances a slippery and soft touch to the composite. See Table 1, page 23. This is an unexpected and surprising result in view of Budden et al.

In short, one of ordinary skill in the art would not add silica particles to the Sato et al. composition because he would believe they increase friction, as expressly taught by Budden et al. The claimed composition exhibits a surprising and unexpected reduction in its coefficient of friction due to the addition of silica particles. Reconsideration and withdrawal of the obviousness rejection of claims 1-14 over Sato et al. in view of Budden et al. are respectfully requested.

The provisional obvious-type double patenting rejection of claims 4 and 12-14 over claims 19, 21, 22, 28, 30 and 32 of copending U.S. application S.N. 11/000,441 is noted. The Office is requested to hold this provisional rejection in abeyance until one of the two applications is allowed, and then apply it, if appropriate, in the other application.

A Supplemental Information Disclosure Statement is attached.

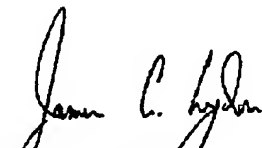
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It is believed this application is in condition for allowance. Reconsideration and withdrawal of all rejections of claims 1-14, and issuance of a Notice of Allowance directed to claims 1-18, are earnestly requested. The Examiner is urged to telephone the undersigned should he believe any further action is required for allowance.

It is not believed any fee is required for entry and consideration of this Amendment. Nevertheless, the Commissioner is authorized to charge our Deposit Account No. 50-1258 in the amount of any such required fee.

Respectfully submitted,


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Enclosure:
Supplemental Information Disclosure Statement